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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,055	07/02/2003	Yoshihisa Makuta	16869P-078100US	6652

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EXAMINER
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PHUONG, DAI

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/613,055

Applicant(s)

MAKUTA, YOSHIHISA

Examiner

Dai A Phuong

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07-02-2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-13 and 16-22 is/are rejected.
- 7) ☒ Claim(s) 3,4,14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 07-02-2003.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 17-21 are objected to because in claim 17, line 1, "In a computer" should be --A computer--, to be clear that applicant is claiming the medium with a program stored thereon. Claims 18-21 are objected to because on line 1, "program" should be --medium--, since base claim 17 is drawn to a medium. If applicant intends claims 17-21 to be drawn to a computer program, *per se*, note the following rejection.

3. Claims 17-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are drawn to a "program" *per se* as recited in each preamble and as such are drawn to non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the

programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 5-6, 9-13, 16-18 and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinnunen et al. (Pub. No: 2001/0018349).

Regarding claim 1, Kinnunen et al. disclose a method of providing access to an information unit by a wireless unit, the method comprising: providing a first position information containing an access enabled area for the wireless unit, the access enabled area falling within a range of communicable area of a wireless access point 114 (fig. 1, [0065]); obtaining a second position information containing a current position of the wireless unit ([0094] to [0095]); if the current position of the wireless unit is within the access enabled area for the wireless unit, then permitting access to the information unit by the wireless unit ([0065] and [0073]); and if the current position of the wireless unit is outside the access enabled area for the wireless unit, then denying access to the information unit by the wireless unit even if the current position of the

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wireless unit is within the range of communicable area of the access point ([0065] and [0073]). Inherently, if the mobile entity 214 is out of service deployment areas 114, it automatically refuses to access services provided by the network 121).

Regarding claim 2, Kinnunen et al. disclose all the limitation in claim 1. Further, Kinnunen et al. disclose the method wherein the first position information contains a plurality of access enabled areas 114 which fall within the range of communicable area of one or more wireless access points, and wherein if the current position of the wireless unit is within one of the access enabled areas, then permitting access to the information unit by the wireless unit ([0065] and [0073]).

Regarding claim 5, Kinnunen et al. disclose all the limitation in claim 1. Further, Kinnunen et al. disclose the method wherein the second position information is obtained from the wireless unit ([0094] to [0095]).

Regarding claim 6, Kinnunen et al. disclose all the limitation in claim 1. Further, Kinnunen et al. disclose the method wherein the wireless access point is a radio LAN access point ([0067] to [0068]).

Regarding claim 9, Kinnunen et al. disclose all the limitation in claim 1. Further, Kinnunen et al. disclose the method comprising monitoring the second position information of the wireless unit and, if the current position of the wireless unit is outside the access enabled area for the wireless unit, then denying access the information unit by the wireless unit ([0110]).

Regarding claim 10, Kinnunen et al. disclose a system for providing access to an information unit by a wireless unit, the system comprising: a memory 216 ([0094]) including a

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first position information containing an access enabled area for the wireless unit, the access enabled area falling within a range of communicable area of a wireless access point ([0133]); a position module 218 ([0094]) configured to obtain a second position information containing a current position of the wireless unit ([0094] to [0095]); and an access module configured 220 and 222 ([0094]), if the current position of the wireless unit is within the access enabled area for the wireless unit, to permit access to the information unit by the wireless unit, and, if the current position of the wireless unit is outside the access enabled area for the wireless unit, to deny access to the information unit by the wireless unit even if the current position of the wireless unit is within the range of communicable area of the access point ([0065] and [0073]).

Regarding claim 11, Kinnunen et al. disclose all the limitation in claim 10. Further, Kinnunen et al. disclose the system wherein the first position information contains a plurality of access enabled areas 114 which fall within the range of communicable area of one or more wireless access points, and wherein if the current position of the wireless unit is within one of the access enabled areas, then permitting access to the information unit by the wireless unit ([0065] and [0073]).

Regarding claim 12, Kinnunen et al. disclose all the limitation in claim 11. Further, Kinnunen et al. disclose the system wherein the access module is configured, if the current position of the wireless unit is within one of the access enabled areas, to permit a same scope of access to the information unit by the wireless unit without regard to which of the access enabled areas within which the current position of the wireless unit is ([0065] and [0073]).

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Regarding claim 13, Kinnunen et al. disclose all the limitation in claim 1. Further, Kinnunen et al. disclose the system wherein the wireless access point is a radio LAN access point ([0067] to [0068]).

Regarding claim 16, Kinnunen et al. disclose all the limitation in claim 1. Further, Kinnunen et al. disclose the system wherein the access module is configured to monitor the second position information of the wireless unit and, if the current position of the wireless unit is outside the access enabled area for the wireless unit, to deny access the information unit by the wireless unit ([0065] and [0095]. Inherently, if the mobile entity 214 is out of service deployment areas 114, it automatically refuses to access services provided by the network 121).

Regarding claim 17, Kinnunen et al. disclose in a computer readable medium storing a program used for providing access to an information unit by a wireless unit, the program comprising: code for providing a first position information containing an access enabled area for the wireless unit ([0094] and [0102]), the access enabled area falling within a range of communicable area of a wireless access point ([0094] and [0102]); code for obtaining a second position information containing a current position of the wireless unit; code for, if the current position of the wireless unit is within the access enabled area for the wireless unit, permitting access to the information unit by the wireless unit ([0094] and [0102]); and code for, if the current position of the wireless unit is outside the access enabled area for the wireless unit, denying access to the information unit by the wireless unit even if the current position of the wireless unit is within the range of communicable area of the access point ([0094] and [0102]. Inherently, it is needed a program to instruct the microprocessor to perform those functions).

Regarding claim 18, Kinnunen et al. disclose all the limitation in claim 17. Further, Kinnunen et al. disclose the program wherein the code for permitting access comprises code for, if the current position of the wireless unit is within one of the access enabled areas, permitting a same scope of access to the information unit by the wireless unit is permitted without regard to which of the access enabled areas within which the current position of the wireless unit is ([0094] and [0102]).

Regarding claim 21, Kinnunen et al. disclose all the limitation in claim 1. Further, Kinnunen et al. disclose the program further comprising code for monitoring the second position information of the wireless unit and, if the current position of the wireless unit is outside the access enabled area for the wireless unit, then denying access the information unit by the wireless unit ([0094] and [0102]).

Regarding claim 22, Kinnunen et al. disclose a method of providing access to an information unit by a wireless unit, the method comprising: providing a first position information containing an access enabled area for the wireless unit ([0065] and [0073]); obtaining a second position information containing a current position of the wireless unit ([0094] to [0095]); if the current position of the wireless unit is within the access enabled area for the wireless unit, then permitting access to the information unit by the wireless unit ([0065] and [0073]); and if the current position of the wireless unit is outside the access enabled area for the wireless unit, then denying access to the information unit by the wireless unit even if the current position of the wireless unit is within the range of communicable area of the access point ([0065] and [0073]). Inherently, if the mobile entity 214 is out of service deployment areas 114, it automatically refuses to access services provided by the network 121).



*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-8 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnunen et al. (Pub. No: 2001/0018349) in view of Mardirossian (Pub. No: 2004/0058693)

Regarding claim 7, Kinnunen et al. disclose all the limitation in claim 1. But, Kinnunen et al. do not disclose the method wherein permitting access comprises adding the wireless unit to an access origination unit list.

In the same field of endeavor, Mardirossian discloses the method wherein permitting access comprises adding the wireless unit to an access origination unit list ([0037]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the mobile entity of Kinnunen et al. by specifically including permitting access comprises adding the wireless unit to an access origination unit list, as taught by Mardirossian, the motivation being in order to attempt to page the pager of the receiving user

Regarding claim 8, the combination of Kinnunen et al. and Mardirossian disclose all the limitation in claim 7. Further, Kinnunen et al. disclose the method comprising periodically obtaining the second position information and, if the current position of the wireless unit is outside the access enabled area for the wireless unit, then removing the wireless unit from the access origination unit list ([0110]).

Regarding claim 19, this claim is rejected for the same reason as set forth in claim 7.

Regarding claim 20, this claim is rejected for the same reason as set forth in claim 8.

#### **Reasons for Allowance**

8. The following is an examiner's statement of reasons for allowance.

Claims 3 and 14 are objected.

Claims 4 and 15 are allowed as being dependent on claims 3 and 14 respectively.

Claim 3 is objected to as being dependent upon a rejected base claim 2, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reason for the indication of allowance: the prior art made of record and considered pertinent to the applicant's disclosure does not disclose nor fairly suggest the method wherein the first position information contains a first access enabled area which falls within the range of communicable area of a first wireless access point, **the first position information including a GPS position of the first access enabled area and a height of the first wireless access point; wherein the second position information includes as the current position of the wireless unit a GPS position information of the wireless unit and a height of the wireless access point through which the wireless unit is evaluated for access to an information unit; and wherein the current position of the wireless unit is within the first access enabled area of the wireless unit if the current position is within the first access enabled area in both the GPS position information and the height.**

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Claim 14 is objected to as being dependent upon a rejected base claim 10, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reason for the indication of allowance: the prior art made of record and considered pertinent to the applicant's disclosure does not disclose nor fairly suggest the system wherein **the access module is configured, if the current position of the wireless unit is within one of the access enabled areas, to permit access to the information unit by the wireless unit by adding the wireless unit to an access origination unit list in the memory.**

### Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Burg et al. (U.S. 6512922) information services provision

Wech (U.S. 6177905) location trigger reminder

Lehikoinen et al. (Pub. No: 2020077060) accessing local services with a mobile

Diggenlen (Pub. No: 20020137523) providing location based information

Wood et al. (Pub. No: 20040203862) logical boundaries in communication networks

Fransioli (Pub. No: 20040298396) location bases messaging

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dai A Phuong whose telephone number is 703-605-4373. The examiner can normally be reached on Monday to Friday, 9:00 A.M. to 5:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dai Phuong

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Date: 04-28-2005

A handwritten signature in black ink, appearing to read 'W. R. Young', with a stylized, flowing script.

W. R. YOUNG  
PRIMARY EXAMINER